

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES**

On behalf of

Steven J. **HARRINGTON**

APPELLANT

Application No.: **10/669,904**

Examiner: **T. Tran**

Filed: **September 24, 2003**

Group Art Unit: **2179**

Confirmation: **5767**

Title: **VIRTUAL PILES DESKTOP INTERFACE**

APPELLANT'S BRIEF ON APPEAL

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GROUP: 2179

APPLICATION: 10/669,904

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CONFIRMATION: 5767

FOR: VIRTUAL PILES DESKTOP INTERFACE

**Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450**

Sir:

APPEAL BRIEF FOR APPELLANT

This Appeal Brief is being submitted in accordance with the Notice of Appeal filed on September 18, 2007 in connection with the above-identified application.

I. REAL PARTY OF INTEREST

The party of real interest to this appeal is the Assignee, Xerox Corporation.

II. RELATED APPEALS AND INTERFERENCES

The Appellant knows of no other pending appeals or interferences that are related to this instant appeal.

III. STATUS OF CLAIMS

Claims 1-46 have been previously presented in this application. Claims 2-22 and 24-46 have subsequently been canceled without prejudice or disclaimer to the subject matter contained therein. Claims 1 and 23 remain pending in the present application. Claims 1 and 23 are appealed.

IV. STATUS OF AMENDMENTS

The Appellant submitted a Response under 37 C.F.R. 1.116 on July 5, 2007, wherein no amendments were presented. The Appellant has not filed any other Responses and/or Amendments subsequent to the Final Office Action, dated May 29, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In accordance with 37 C.F.R. 41.37(2)(c)(v), the following are concise explanations of the subject matter defined in the independent claim (1) involved in this Appeal.

Independent claim 1 recites a method for managing a plurality of opened documents being displayed on an electronic desktop of an electronic device, an opened document being an application invoked created area on the electronic desktop of the electronic device, the opened document displaying the contents of an electronic file. The method displays a first icon associated with a first opened document in a

predetermined form (see, for example, **DOC1** of Figure 1 and paragraph [0008] of the US Published Patent Application (2005/0066292) corresponding to the above-identified application or page 2, line 14 to page 3, line 2 of the originally filed specification).

The method also displays a second icon associated with a second opened document in the predetermined form (see, for example, **DOC2** of the left half of Figure 1 and paragraph [0008] of the US Published Patent Application (2005/0066292) corresponding to the above-identified application or page 2, line 14 to page 3, line 2 of the originally filed specification).

A third icon associated with a third opened document in the predetermined form is displayed (see, for example, **DOC3** of Figure 1 and paragraph [0008] of the US Published Patent Application (2005/0066292) corresponding to the above-identified application or page 2, line 14 to page 3, line 2 of the originally filed specification).

The method further selects the first icon associated with the first opened document being displayed on the electronic desktop of the electronic device and places the first icon associated with the first opened document onto the second icon associated with the second opened document (see, for example, **DOC2** of the right half of Figure 1 and paragraphs [0004] of the US Published Patent Application (2005/0066292) corresponding to the above-identified application or page 1, line 20 to page 2, line 7 of the originally filed specification and [0008] of the US Published Patent Application (2005/0066292) corresponding to the above-identified application or page 2, line 14 to page 3, line 2 of the originally filed specification).

The method also modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document and displays a virtual pile icon representing a virtual pile when the first icon is placed onto the second icon, the virtual pile icon having an appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document thereunder (see, for example, **DOC2** of the right half of Figure 1 and paragraphs [0008] - [0010] of the US Published Patent Application (2005/0066292) corresponding to the

above-identified application or page 2, line 14 to page 3, line 17 of the originally filed specification).

The method selects the third icon associated with the third opened document being displayed on the electronic desktop of the electronic device and places the third icon associated with the third opened document onto the virtual pile icon (see, for example, **DOC2** of the right half of Figure 1 and paragraphs [0004] of the US Published Patent Application (2005/0066292) corresponding to the above-identified application or page 1, line 20 to page 2, line 7 of the originally filed specification and [0008] of the US Published Patent Application (2005/0066292) corresponding to the above-identified application or page 2, line 14 to page 3, line 2 of the originally filed specification).

Finally, the method modifies an appearance of the third icon associated with the third opened document to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon and modifies the appearance of the virtual pile icon, the virtual pile icon having the appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document and the second single line segment representing the third icon associated with the third opened document thereunder (see, for example, **DOC2** of the right half of Figure 1 and paragraphs [0008] - [0010] of the US Published Patent Application (2005/0066292) corresponding to the above-identified application or page 2, line 14 to page 3, line 17 of the originally filed specification).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issue is whether claims 1 and 23 are patentable over Czerwinski et al. (Published US Patent Application 2004/0066414) in view of Mander et al. (US Patent 6,243,742) in accordance with 35 U.S.C. §103.

VII. ARGUMENTS

Claims 1 and 23 have been rejected under 35 U.S.C. §103 as being unpatentable over Czerwinski et al. (Published US Patent Application 2004/0066414) in view of Mander et al. (US-A-6,243,742). This rejection under 35 U.S.C. §103 is respectfully traversed.

In formulating the rejection under 35 U.S.C. §103, the Examiner alleges that Czerwinski et al. discloses a method that selects a first icon associated with a first opened document being displayed on the electronic desktop of the electronic device; places the first icon associated with the first opened document onto a second icon associated with a second opened document; and modifies an appearance of the first icon associated with the first opened document to represent a portion of a virtual pile of opened documents when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document.

The Examiner further alleges that Czerwinski et al. discloses a method that maintains an appearance of the second icon when the first icon is placed onto the second icon; selects a third icon associated with a third opened document being displayed on the electronic desktop of the electronic device; places the third icon associated with the first opened document onto the second icon associated with the second opened document; modifies an appearance of the third icon associated with the third opened document to represent a portion of the virtual pile of opened documents when the third icon associated with the third opened document is placed onto the second icon associated with the second opened document; and maintains the appearance of the second icon when the third icon is placed onto the second icon.

However, the Examiner recognizes that Czerwinski et al. fails to disclose modifying an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document. Moreover, the Examiner recognizes that Czerwinski et al. fails to disclose modifying an appearance of the third icon associated with the third opened document to display a

second single line segment when the third icon associated with the third opened document is placed onto the second icon associated with the second opened document.

To meet this deficiency in Czerwinski et al., the Examiner proposes to modify the teachings of Czerwinski et al. with the teachings of Mander et al. The Examiner alleges that "within the scope and spirit of the disclosed invention," Mander et al. teaches modifying an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document.

Furthermore, the Examiner alleges that "within the scope and spirit of the disclosed invention," Mander et al. teaches modifying an appearance of the third icon associated with the third opened document to display a second single line segment when the third icon associated with the third opened document is placed onto the second icon associated with the second opened document.

From these allegations, the Examiner concludes that the combined teachings of Czerwinski et al. and Mander et al. render the presently claimed invention obvious to one of ordinary skill in the art. This allegations and conclusion are respectfully traversed.

Independent Claim 1

As set forth in the Clams Appendix, independent claim 1 recites a method for managing a plurality of opened documents being displayed on an electronic desktop of an electronic device, an opened document being an application invoked created area on the electronic desktop of the electronic device by displaying a first icon associated with a first opened document in a predetermined form; displaying a second icon associated with a second opened document in the predetermined form; displaying a third icon associated with a third opened document in the predetermined form; and selecting the first icon associated with the first opened document being displayed on the electronic desktop of the electronic device; placing the first icon associated with the first opened document onto the second icon associated with the second opened document.

The method modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document; displaying a virtual pile icon representing a virtual pile when the first icon is placed onto the second icon, the virtual pile icon having an appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document thereunder.

The method further selects the third icon associated with the third opened document being displayed on the electronic desktop of the electronic device; places the third icon associated with the third opened document onto the virtual pile icon; modifies an appearance of the third icon associated with the third opened document to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon; and modifies the appearance of the virtual pile icon, the virtual pile icon having the appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document and the second single line segment representing the third icon associated with the third opened document thereunder.

Czerwinski et al. teaches, at paragraph [0037], and illustrates in Figures 2A and 2B, a method that creates a group icon **126**), having an appearance of an oval, when two icons (**118**, **120**) are joined together. As clearly illustrated by Czerwinski et al., in Figures 2A and 2B, the group icon **126** provides a border around the two icons (**118**, **120**) to illustrate the relationship; however, Czerwinski et al. teaches and illustrates that the oval appearance of the two icons (**118**, **120**) within the group icon **126** are maintained.

In contrast, independent claim 1 explicitly recites that an appearance of the first icon associated with the first opened document is modified to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document. Furthermore, independent claim 1 explicitly recites that a virtual pile icon representing a virtual pile is displayed when the first icon is placed onto the second icon, the virtual pile icon having an appearance of the second icon in the predetermined form with the first single line

segment representing the first icon associated with the first opened document thereunder.

Moreover, in Figure 7, Czerwinski et al. teaches and illustrates that the oval appearance of the icons (**118**, **120**, and **140**) within the group icon **140** are maintained. As stated above, independent claim 1 explicitly recites that an appearance of the first icon associated with the first opened document is modified to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document. Also, independent claim 1 explicitly recites that an appearance of the third icon associated with the third opened document is modified to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon.

Although Czerwinski et al. teaches the creation of a group icon, the individual icons, which created the group, are **not** modified in appearance, but remain unchanged. Thus, Czerwinski et al. fails to teach or suggest that an appearance of the first icon associated with the first opened document is modified to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document and/or an appearance of the third icon associated with the third opened document is modified to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon.

As noted above, independent claim 1 recites a method that modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document. Moreover, independent claim 1 recites displaying a virtual pile icon representing a virtual pile when the first icon is placed onto the second icon, the virtual pile icon having an appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document thereunder.

In other words, the virtual pile icon of independent claim 1 includes the second icon in the predetermined form (unchanged) and the first single line segment representing the first icon (changed) associated with the first opened document.

This allows the majority of the virtual pile icon's visual identification to remain unchanged. By keeping the majority of the virtual pile icon's visual identification unchanged, a user can easily recognize the virtual pile and remember the contents thereunder. Moreover, the maintaining of the majority of the virtual pile icon's visual identification allows the use to insert documents into the pile using a single step without disrupting the visual identification of the virtual pile.

To address this deficiency in Czerwinski et al., the Examiner asserts that **"within the scope and spirit of the disclosed invention,"** Mander et al. suggests modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon.

It is readily apparent from the Examiner's remarks that the Examiner recognizes that Mander et al., on its face, fails to disclose or suggest modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon. Notwithstanding, the Examiner is apparently asserting that somewhere in the nebulous and undefined realm of the "scope and spirit" of Mander et al., one of ordinary skill in the art would stumble upon a suggestion to modify an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon.

Initially, as noted above, the Examiner is relying upon an unknown or undefined entity when the Examiner asserts that that **"within the scope and spirit of the disclosed invention,"** Mander et al. suggests modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon. If this "scope and spirit" of Mander et al. is a quantifiable and definable entity, it is respectfully requested that the Examiner provide documented evidence demonstrating the boundaries of the "scope and spirit" of the disclosed invention of Mander et al. Does the Examiner mean that the claims (the conventional vehicle for defining the "scope" of a disclosed invention) teach modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon? What is the test for discerning the "spirit" of the disclosed invention?

It is respectfully submitted that the Examiner's reliance upon an alleged suggestion "within the scope and spirit of the disclosed invention" is outside the scope of a proper analysis of obviousness under 35 U.S.C. §103.

However, assuming, en arguendo, that the Examiner can hypothesize about "the scope and spirit of the disclosed invention" to create a suggestion, the suggestion created by the Examiner is contrary to the plain teachings of Mander et al.

As recognized by the Examiner, the plain teachings of Mander et al. disclose that the virtual pile's appearance is modified to reflect the icon of a first document when the first icon is placed onto the virtual pile. Notwithstanding this explicit teaching, the Examiner asserts that since Mander et al. teaches modifying the appearance of the first icon associated with the first document when the first icon is placed within the virtual pile (Mander et al. teaches that when the icon associated with the first document is placed within the virtual pile, the icon associated with the first document is changed), one of ordinary skill in the art would discover a suggestion to modify an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon.

Although Mander et al. teaches the ability to place the icon associated with the first document within the virtual pile, this placement requires more than dropping the icon of the document onto the icon of the virtual pile. Mander et al. teaches that to place the icon associated with the first document within the virtual pile, the icon of the document is held over the virtual pile until the pile is partially de-stacked to show the user various available locations in which the icon can be placed. If the user desires a different location within the stack, Mander et al. teaches that a movement of the cursor will create another location or set of locations for placing the icon. Once the location is selected, Mander et al. teaches that the user releases the icon to that location within the pile.

Mander et al. teaches this de-stacking of the pile for icon placement so that the virtual pile is a true replica of a physical pile of documents. When placing a physical document on top of a document pile, the document is physically on the top of the pile. In other words, Mander et al. teaches that when an icon representing a document is placed upon the top of an icon of a virtual pile, the icon representing the document is

visually represented on top of the pile. Thus, the “scope and spirit” of Mander et al. is to create a virtual system which is a faithful replica of the corresponding physical system.

On the other hand, the claimed invention does not faithfully replicate a physical pile. As set forth by independent claim 1, when the first icon is placed onto the second icon, an appearance of the first icon is modified to display a first single line segment and the appearance of the second icon remains on top of the virtual pile, as opposed to the appearance of the first icon being on top of the virtual pile if the system was faithfully replicating the characteristics of a physical pile.

Moreover, as set forth by independent claim 1, when the third icon is placed onto the second icon, an appearance of the third icon is modified to display a another single line segment and the appearance of the second icon remains on top of the virtual pile, as opposed to the appearance of the third icon being on top of the virtual pile if the system was faithfully replicating the characteristics of a physical pile.

Therefore, contrary to the Examiner’s allegation, the “scope and spirit” of Mander et al., fails to suggest to one of ordinary skill in the art to modify an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon.

In summary, since Czerwinski et al. and Mander et al. each singly fails to teach or suggest a method that modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document, the combined teachings of Czerwinski et al. and Mander et al. fail to teach or suggest a method that modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document.

Conclusion

Accordingly, for all the reasons set forth above, the Honorable Board is respectfully requested to reverse all the outstanding rejections. Also, an early indication of allowability is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Nickerson', with a stylized flourish at the end.

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VIII. CLAIMS APPENDIX

1. (Appealed) A method for managing a plurality of opened documents being displayed on an electronic desktop of an electronic device, an opened document being an application invoked created area on the electronic desktop of the electronic device, the opened document displaying the contents of an electronic file, comprising:

(a) displaying a first icon associated with a first opened document in a predetermined form;

(b) displaying a second icon associated with a second opened document in the predetermined form;

(c) displaying a third icon associated with a third opened document in the predetermined form;

(d) selecting the first icon associated with the first opened document being displayed on the electronic desktop of the electronic device;

(e) placing the first icon associated with the first opened document onto the second icon associated with the second opened document;

(f) modifying an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document;

(g) displaying a virtual pile icon representing a virtual pile when the first icon is placed onto the second icon, the virtual pile icon having an appearance of the second

icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document thereunder;

(h) selecting the third icon associated with the third opened document being displayed on the electronic desktop of the electronic device;

(i) placing the third icon associated with the third opened document onto the virtual pile icon;

(j) modifying an appearance of the third icon associated with the third opened document to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon; and

(k) modifying the appearance of the virtual pile icon, the virtual pile icon having the appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document and the second single line segment representing the third icon associated with the third opened document thereunder.

23. (Appealed) A method as in claim 1, further comprising:

(l) providing information regarding an opened document in the virtual pile, when a mouse-over event is initiated upon the icon in the virtual pile representing the opened document.

IX. EVIDENCE APPENDIX

NONE

X. RELATED PROCEEDINGS APPENDIX

NONE